

The opinion in support of the decision being entered today **was** not written for publication and is **not** precedent of the Board.

Paper No. 38

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE J. BARKER

Appeal No. 1998-0665
Application 08/303,128

ON BRIEF

Before BARRETT, FLEMING and HECKER, **Administrative Patent Judges**.

HECKER, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 21 through 30. Appellant subsequently canceled claims 21 through 27 (paper no. 26, received July 3, 1996), leaving claims 28 through 30 under appeal, which constitute all claims remaining in this application.

The invention relates to a handheld computer peripheral for a computer with voice recognition software. In particular, with respect to Figure 3, the peripheral 40 has a microphone 42, a voice command button 48, a voice data button (record) 46, and a cursor position transducer 44. The voice data button and voice command button cooperate to allow the user to rapidly change between command and data input without any ambiguity as to how the voice should be interpreted by the voice recognition software.

Independent claim 28 is reproduced as follows:

28. A data entry system comprising a handheld peripheral and a processing system, wherein

said handheld peripheral comprises:

a microphone for providing a microphone signal representative of a user's voice,

a voice command button for providing a command notification signal indicating whether said voice command button is asserted,

a voice data button for providing a data notification signal indicating whether said voice data button is asserted,

a cursor position transducer for providing a cursor signal representative of a desired cursor position on a display screen of said processing system, and

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a coupling mechanism for providing said microphone signal, said command notification signal, said data notification signal, and said cursor signal to said processing system; and wherein

said processing system comprises:

said display screen, and

microphone interpretation mechanism which, in response to said command and data notification signals, determines when said microphone signal represents command and when it represents data.

The Examiner relies on the following references:

Redford	5,339,095	Aug. 16, 1994
		(filed Dec. 5, 1991)

White	5,386,494	Jan. 31, 1995
		(effectively filed Dec. 6, 1991)

"IBM Independence Series VoiceType User's Guide,"
International Business Machines Corporation,, pp. 28-41 and
60-77 (VoiceType) (1991).

Claims 28 through 30 stand rejected under 35 U.S.C.
§ 103 as being unpatentable over Redford in view of VoiceType
and White.

Rather than reiterate the arguments of Appellant and
the Examiner, reference is made to the brief, reply brief and
answer for the respective details thereof.

OPINION

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After a careful review of the evidence before us, we will not sustain the rejection of claims 28 through 30 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995) (*citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

With respect to claim 28, the Examiner reasons that Redford discloses the claimed invention except for a voice command button, a voice data button and a microphone

interpretation mechanism. The Examiner notes that VoiceType discloses a system with microphone interpretation of voice commands and voice data. Additionally, the Examiner notes that White discloses a system with a microphone button which allows the microphone interpretation mechanism to determine when the

microphone signal represents commands. (Answer-page 4.) The Examiner further states:

Accordingly, it would have been obvious to utilize voice command/voice data capabilities as taught by VoiceType in the input device disclosed by Redford because Redford clearly is directed toward providing meaningful audio input to the computer (see column 1, line 67 to column 2, line 2; column 3, lines 45-49; column 10, lines 19-35). Further, it would have been obvious to one of ordinary skill in the art to provide a user controlled data button and a user controlled command button in the combined apparatus of Redford and Voice Type so that the computer does not mistakenly interpret commands as dictated text and dictated text as commands as suggested by White. [Answer-page 5.]

Appellant argues that White's limiting of the number of possible commands, by selecting an object on the screen, does not teach or suggest the claimed data and command buttons

for unambiguously distinguishing spoken commands from data (brief-page 5). We agree, White's button only activates the microphone, and does not distinguish between spoken data and spoken commands.

The Examiner's statement that the combination of references

would have inferred the desirability of using buttons to distinguish between voice input signals representing data and voice input signals representing commands. [Answer-page 5.]

is a stretch that reaches clearly into the realm of improper hindsight. We are in total agreement with Appellant's statement in the reply brief wherein Appellant states:

Applicant respectfully submits that the Examiner has inadvertently employed hindsight in an attempt to piece together the invention from a carefully selected collection of prior art references. Even with the benefit of such hindsight, however, the Examiner was still unable to find certain aspects of the invention in the prior art, and therefore resorted to "reasonable inferences" [answer-page 5] to fill the voids.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In**

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re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." **Para-Ordnance Mfg. v. SGS Importers Int'l**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.**, 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13.

As pointed out above, Redford, White and VoiceType do not teach or suggest (or infer) the use of a handheld peripheral with separate buttons for voice command spoken words and voice data spoken words. Since there is no evidence in the record that the prior art suggested the desirability of such buttons, we will not sustain the Examiner's rejection of claim 28.

The remaining claims on appeal also contain the above limitations discussed in regard to claim 28 and thereby, we will not sustain the rejection as to these claims.

We have not sustained the rejection of claims 28 through 30 under 35 U.S.C. § 103. Accordingly, the Examiner's

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decision is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
STUART N. HECKER)	
Administrative Patent Judge)	

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